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EXAMINER

KLIMOWICZ, WILLIAM JOSEPH

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/029,984
Filing Date: December 31, 2001
Appellant(s): KIM ET AL.

Derrick L. Fields
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 7, 2004.

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is incomplete. The Appellants' status of claims fails to mention that claims 1-13 have been cancelled. Additionally, after careful reconsideration of independent claim 16, claim 16 has been allowed (as well as claims 17-24, which depend from claim 16). Thus, a correct, complete and updated statement of the status of the claims is as follows:

Claims 14-24 are currently pending.

Claims 1-13 have been voluntarily cancelled by the Appellants.

Claims 14 and 15 stand rejected on the grounds of rejection, articulated in section (10), *infra*.

Claims 16-24 are allowed over the art of record for the reasons espoused in the Reasons for Allowance section (11), *infra*.

(4) *Status of Amendments After Final*

The Appellants' statement of the status of amendments after final rejection contained in the brief is correct.

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(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The Appellants' statement of the issues in the brief as it pertains to rejected claims 14 and 15 is correct.

(7) *Grouping of Claims*

Appellants' brief includes a statement that claims 14 and 15 (Group I) and claims 16-21 (Group II) do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8). It is noted that Claims 16-24 have now been allowed, and as such, Claims 14 and 15 as a Group stand or fall together.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

6,438,087 B2	OMORI	08-2002
5,123,005	KUROSU	06-1992

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the Appellant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the Appellant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 14 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Omori (US 6,438,087 B2).

As per claim 14, Omori (US 6,438,087 B2) discloses an optical disc reproduction apparatus (5) (e.g. see, *inter alia*, FIG. 4) to reproduce data from an optical disc (1), comprising: a main body (outer cabinet housing of disc drive device as seen, e.g. *inter alia*, in FIG. 4); a tray (2) slidably installed in the main body; an optical pickup device (42, 44) to reproduce data on the optical disc (1); and, as broadly set forth in the instantly claimed invention, a damping unit (e.g., 19, 20) to absorb shock when the tray (2) is unloaded from the main body. More concretely, when the tray is in the processing of being ejected from the housing main body (cf, FIGS. 5 and 4, respectively), the damper members minimize the vibration transmitted to the chassis (16), since the vibration damper (e.g., 20) is located between connection portion (18) and portion (23) and when the chassis moves downward when the tray is unloaded, the vibration from (23) contacting portion base (14b) is minimized due to the intervening damper (20), as is well recognized by those having skill in the art. Moreover still, the isolation dampers (19, 20) seek to minimize and/or isolate any and all vibration that are transmitted through the cabinet housing and/or tray to the chassis by completely decoupling direct mechanical contact of the pickup chassis (16) with the cabinet structural components (including the tray). That is, the damping unit (19, 20) minimizes vibration to the pickup chassis (16) *when* the tray is loaded (fully loaded or partially loaded); the damping unit (19, 20) minimizes vibration to the pickup chassis (16) *when* the tray is unloaded (fully unloaded or partially unloaded); the damping unit (19, 20)

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minimizes vibration to the pickup chassis (16) *when* the optical pickup device is in a reproduction state, etc. In short, the damping unit (19, 20) seeks to minimize vibration at all times, no matter what the origin of the source of vibration.

Additionally, as broadly set forth in claim 15, the damping unit (19, 20) absorbs shock during reproduction of the data on the optical disc (1). More concretely, the dampers isolate any direct mechanical contact between the chassis, which supports the optical pickup (42, 44). Thus any vibration that is imparted to the housing, is not directly transmitted to the chassis and is absorbed by the intervening damping vibrations isolators (19) and (20).

(11) *Reasons for Allowance of Claims 16-24*

The following is an Examiner's statement of reasons for allowance of claims 16-24, after a careful reconsideration of the claim language and the applied references:

The prior art of record fails to fairly, teach, show or suggest, by either anticipating or rendering obvious, the invention as set forth in claims 16-24 of the instant application.

Furthermore, an update of a search previously made does not detect the combined claimed elements as set forth in the pending claims 16-24.

More particularly, the instant invention (as set forth in independent claim 16) provides for an optical disc changer (e.g., 200), comprising: a main body (e.g., 210); a tray (e.g., 250) slidably installed in the main body (e.g., 210) to accommodate a plurality of optical discs; an optical pickup device (e.g., 220) to reproduce one of the optical discs; a stop member (e.g., 251 and/or 252) and a hook step (e.g., 242) provided at the tray (e.g., 250) and the main body (e.g., 210), respectively, to prevent the tray (e.g., 250) from escaping from the main body (e.g., 210) during unloading; and a damper (e.g., 243) to absorb an impact when the stop member (e.g., 251 and/or

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252) and the hook step (e.g., 242) bump against each other (colliding contact).

The closet prior art includes Kurosu (US 5,123,005) who discloses an optical disc changer, comprising: a main body (2); a tray (7) slidably installed in the main body (2) to accommodate a plurality of optical discs (20); an optical pickup device (45) to reproduce one of the optical discs (20); a stop member (14) and a hook step (portion of chassis on which the elastic portion of (6) is mounted) provided at the tray (7) and the main body (2), respectively, to prevent the tray (7) from escaping from the main body (2) during unloading; and a damper (elastic member of element (6)) to absorb an impact when the stop member (14) and the hook step (mounting portion of (6)) approach each other, but do not bump against each other (due to the intervening elastic member (6)).

Kurosu (US 5,123,005), however, does not disclose wherein the damper (6) absorbs an impact when the stop member and the hook step bump against each other. That is, the damper (elastic portion (6)) prevents the hook step (portion upon which rubber element (6) is mounted) from ever bumping against (colliding contact) the stop member (14); the hook step and step member of never make contact, i.e., the hook step (portion of chassis on which the elastic portion of (6) is mounted) and the step member (14) never bump against each other, as required by claim 16 due to the intervening member (i.e., the elastic damper (6)).

Thus, Kurosu (US 5,123,005) does not disclose the invention as set forth in the manner, function and relationship relative to other claimed structure as prescribed by the independent claim 16.

Additionally, Kurosu (US 5,123,005) does not provide, alone or in combination with the art of record or general knowledge within the art, any suggestion or teaching for the invention as

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set forth in the independent claim 16.

(12) Response to Argument

The Appellants' allege the following as it pertains to the rejection of claims 14 and 15 as being anticipated by Omori (US 6,438,087 B2) (see page 4, second to last paragraph of the Appellants' Brief):

As mentioned in the response filed May 26, 2004, the Examiner's assertion is not supported by the teachings of Omori. Nothing in the Omori reference discloses that the insulators 19 and 20 of Omori are used to absorb shock when the tray 2 is unloaded. As indicated in column 2, lines 56-66, when the disc tray 2 is unloaded, the lift frame 16 is driven in the downward direction (c2) and does not allow the insulators 19 and 20 to come in contact with the disc tray 2. Therefore, it cannot be suggested that one skilled in the art would recognize that the insulators 19 and 20 are the same as the claimed damping unit to absorb shock when a tray is unloaded as recited in claim 14 of the present invention.

The Examiner notes that all the claims require is "a damping unit to absorb shock when the tray is unloaded from the main body." The overly broad scope of claims 14 and 15 do not in any way, shape or form, require the damping unit to be affixed to *anything* within the optical disc reproduction unit, let alone any structure which interacts with the tray directly or indirectly. In fact, the claims do not require that the damping unit to affixed to the optical disc reproduction unit at all. All that the claim requires is a damping unit (affixed to anything, possibly the optical disc reproduction unit, possibly not) to absorb shock - shock from the disc tray hitting something? - Yes; Shock from an earthquake that transmits it vibration to a computer and/or the disc drive of Omori (US 6,438,087 B2)? - Certainly; Nothing in the broad scope of claims 14 or 15 require a specific structural source or origin of a shock; Does the tray have to be opened (at

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least partially) for the damping unit to absorb shock? - Yes; Does the claim require that the damping unit **only** absorb shock when the tray is fully or partially unloaded? - Certainly not.

As set forth in the rejection, *supra*, the isolation dampers (19, 20) seek to minimize and/or isolate any and all vibrations that are transmitted through the cabinet housing and/or tray to the chassis by completely decoupling direct mechanical contact of the pickup chassis (16) with the cabinet structural components (including the tray). That is, the damping unit (19, 20) minimizes vibration to the pickup chassis (16) **when** the tray is loaded (fully loaded or partially loaded); the damping unit (19, 20) minimizes vibration to the pickup chassis (16) **when** the tray is unloaded (fully unloaded or partially unloaded); the damping unit (19, 20) minimizes vibration to the pickup chassis (16) **when** the optical pickup device is in a reproduction state, etc. In short, the damping unit (19, 20) seeks to minimize vibration at all times, no matter what the origin of the source of vibration, be it a tray that transmits vibration by hitting other cabinet structure or by a careless user hitting an open tray, thus transmitting vibration to the disc drive through the tray; an earthquake causing the vibration, etc.

Pertaining to the claims 14 and 15 rejected under 35 U.S.C. § 102 as being anticipated by the disclosure of Omori (US 6,438,087 B2), the following should be noted. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. *RCA Corp. v. Applied Digital Data Systems, Inc.*, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); *cert. dismissed*, 468 U.S. 1228 (1984); *W.L. Gore and Associates, Inc. v. Garlock, Inc.*, 72.1 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

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The Examiner, as clearly articulated in the rejections, *supra*, has set forth a one-to-one correspondence with each and every element of the *claimed* invention.

As recited MPEP§2106:

Office personnel are to give claims their ***broadest reasonable interpretation*** in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). ***Limitations appearing in the specification but not recited in the claim are not read into the claim.*** *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969). *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (“During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow. . . . The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed. . . . An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.”). [Emphasis in bold italics added].

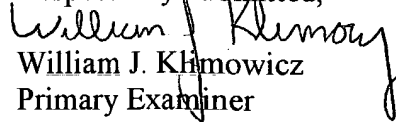
Moreover, one must also bear in mind that limitations contained within Appellants’ arguments cannot be read into the claims for the purpose of avoiding prior art. *In re Sporck*, 386 F.2d 924, 155 USPQ 687 (CCPA 1968).

As set forth in the MPEP§ 706, “the standard to be applied in all cases is the ‘preponderance of the evidence’ test. In other words, an examiner should reject a claim if, in view of the prior art and evidence of record, it is more likely than not that the claim is unpatentable.” Clearly, the Examiner has established that one of ordinary skill in the art would *reasonably* construe the one-to-one correspondence with each and every element of the *claimed* invention, in the manner set forth in the rejection, *supra*, by at least the *preponderance* of the evidence. The Appellants’ arguments have fallen well short of rebutting the Examiner’s *prima facie* case of anticipation.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


William J. Klimowicz
Primary Examiner
Art Unit 2652

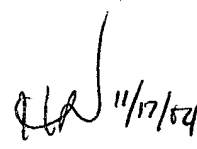
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November 17, 2004

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